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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,816	12/04/2000	Richard John Barry	450110-02873	5258

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FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER
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COULTER, KENNETH R

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/674,816

Applicant(s)

BARRY ET AL.

Examiner

Kenneth R Coulter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## DETAILED ACTION

### *Specification*

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 – 28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 12 of U.S. Patent No. 6,591,419. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the present Application and U.S. Pat. No. 6,591,419 disclose a conditional access subunit for connection to an IEEE 1394 (fire wire) network, the subunit including:

means to receive AV/C Conditional Access Commands over the IEEE 1394 network from another subunit; and

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means to transmit the AV/C responses over the IEEE 1394 network in response to the received AV/C Conditional Access Commands.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1 – 12, 14 – 25, and 28 are rejected under 35 U.S.C. 102(e) as being disclosed by Cheng et al. (U.S. Pat. No. 6,040,851) (Small-Format Subsystem for Broadband Communication Services).

5.1 Regarding claim 1, Cheng discloses a conditional access subunit for connection to an IEEE 1394 (fire wire) network, the subunit including:

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means to receive AV/C Conditional Access Commands over the IEEE 1394 network from another subunit (Abstract; Figs. 1, 3; col. 3, lines 22 - 31); and

means to transmit the AV/C responses over the IEEE 1394 network in response to the received AV/C Conditional Access Commands (Figs. 1, 2A, 2B; col. 6, lines 20 - 23 “**DICAMs** can be implemented to provide any of the following **output signal types** or protocols: serial bitstream ... **IEEE 1394 (Fire Wire)** ...”).

5.2 Per claims 4 - 12, and 14 - 24, Cheng does not disclose the specifics involving particular commands.

Cheng does disclose that “the DICAM may also include an interface for ‘Smartcards’ that implement **any of the different varieties of CA functions** currently found around the world.” (col. 4, lines 58 - 60).

Therefore, these commands are inherent in Cheng since the enable command is commonplace in network scenarios.

5.3 Regarding claims 2 and 3, the rejection of claim 1 (paragraph 5.1 above) under 35 USC 102(e) applies fully.

5.4 Per claim 25, Cheng teaches a conditional access subunit for connection to an IEEE 1394 network for use in descrambling a transport stream received over the network (Fig. 3, items 112, 126; col. 5, lines 13 - 25) wherein the conditional access subunit, having descrambled the transport stream, introduces a local scrambling before

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retransmitting the transport stream to other subunits on the network, such that only authorized subunits on the network capable of local descrambling can receive the information in the transport stream (Fig. 3, item 130; col. 5, lines 5 - 12).

5.5 Regarding claim 28, Cheng discloses a tuner device having an embedded conditional access subunit (Fig. 3).

6. Claims 26 and 27 are rejected under 35 U.S.C. 102(e) as being disclosed by Newby et al. (U.S. Pat. No. 5,796,829 (Conditional Access System)).

6.1 Regarding claim 26, Newby discloses a conditional access subunit for connection to an IEEE 1394 network having a tuner subunit (Fig. 1, item 30; Fig. 3, item 122), the conditional access subunit having means for periodically contacting the tuner subunit to request the received transport stream for a period of time sufficient to allow the conditional access subunit to update the entitlement management messages stored in the conditional access subunit (Fig. 1; col. 3, lines 7 - 26).

6.2 Per claim 27, the rejection of claim 26 (paragraph 6.1 above) under 35 USC 102(e) applies fully.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R Coulter whose telephone number is 703 305-8447. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 703 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

krc

KENNETH R. COULTER  
PRIMARY EXAMINER  
